

Atty Dkt. No.: 10010010-1
USSN: 10/066,516

REMARKS

Formal Matters

Claims 1-38 are pending.

Claims 1-38 were examined and rejected.

Claims 7, 22 and 33 are amended for clarity. No new matter is added.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Interview Summary

Examiners Negin and Brusca are thanked for the telephonic interview with the Applicants' representative James S. Keddle July 12, 2006.

An agreement was reached.

Examiners Negin and Brusca agreed that Harris (6,388,788) was deficient for failing to teach all of the elements of claim 1. As such, the rejection of claims 1-3 and 11 under 35 U.S.C. §102 would be withdrawn.

Examiners Negin and Brusca further agreed that the secondary references cited in the rejections under 35 U.S.C. §103 did not meet Harris' deficiency. As such, all of the rejections under 35 U.S.C. §103 would be withdrawn.

During the interview, Examiner Negin mentioned that the instant claims may be rejectable over U.S. Patent No. 6,083,763 ("the '763 patent"). As noted by the Applicants, however, the '763 patent and the instant application were commonly owned by Agilent at the filing date of the instant application. As such, the '763 patent cannot preclude the patentability of the instant claims.

In view of the deficiencies of the current rejections, a timely Notice of Allowance is requested.

Claim objections

Claims 7, 9, 22-28 and 33-35 are objected to because of minor informalities.

Claims 7, 22 and 33 have been amended in accordance with the Examiner's kind suggestions.

Withdrawal of the claim objections is respectfully requested.

Atty Dkt. No.: 10010010-1
USSN: 10/066,516

Rejection of claims under 35 U.S.C. § 102 - Harris

Claims 1-3 and 11 are rejected under 35 U.S.C. § 102(e) as being anticipated by Harris (U.S. Patent No. 6,388,788). The Applicants respectfully traverse this rejection.

The claims are directed to methods and compositions that involve automatic retrieval of signal data and feature extraction. In one exemplary embodiment described in claim 1, the method may include extracting feature characteristics from a first array while a second array is being read.

Harris describes a high throughput confocal microscopy system for analyzing samples in a microtiter plate (which is interpreted to be a chemical array by the Examiner). According to the Office Action, Harris' reading and data processing steps are simultaneous and therefore Harris describes a method that includes all of the elements of the rejected claims.

As discussed and agreed during the aforementioned interview, however, Harris fails to disclose any method that involves reading one plate at the same time as processing data for another plate. As such, Harris fails to disclose all of the rejected claims, and this rejection may be withdrawn.

Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103 – Harris in view of Besemer

Claims 1 and 5-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Besemer (U.S. Patent No. 6,399,365). The Applicants respectfully traverse this rejection.

It is well established that correctly formulated *prima facie* case of obviousness requires that all the elements of the rejected claims are taught or reasonably suggested.

In attempting to establish this rejection, the Examiner argues that Harris' scanning methods, in combination with Besemer's identifier system, renders claims 1 and 5-9 unpatentable.

As established above, Harris' disclosure is deficient because it fails to disclose any method that involves reading one plate at the same as processing data for another.

Besemer, like Harris, fails to disclose any method that involves reading one plate at the same as processing data for another. As such, Besemer's disclosure fails to meet Harris' deficiency.

Atty Dkt. No.: 10010010-1
USSN: 10/066,516

In view of the above, the Applicants submit that Harris and Besemer, taken in any combination, fail to teach or reasonably suggest each and every element of the rejected claims.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103 – Harris in view of Rava

Claims 1, 10, 12, 13 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Rava (U.S. Patent No. 5,874,219). The Applicants respectfully traverse this rejection.

It is well established that correctly formulated *prima facie* case of obviousness requires that all the elements of the rejected claims are taught or reasonably suggested.

In attempting to establish this rejection, the Examiner argues that Harris' scanning methods, in combination with Rava's multiple reading stations, renders claims 1, 10, 12, 13 and 16 unpatentable.

As established above, Harris' disclosure is deficient because it fails to disclose any method that involves reading one plate at the same as processing data for another.

Rava, like Harris, fails to disclosure any method that involves reading one plate at the same as processing data for another. As such, Rava's disclosure fails to meet Harris' deficiency.

In view of the above, the Applicants submit that Harris and Rava, taken in any combination, fail to teach or reasonably suggest each and every element of the rejected claims.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103 – Harris in view of Rava and Ambrose

Claims 22, 23, 29 and 33 are rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Rava and Ambrose (6,309,886). The Applicants respectfully traverse this rejection.

It is well established that correctly formulated *prima facie* case of obviousness requires that all the elements of the rejected claims are taught or reasonably suggested.

In attempting to establish this rejection, the Examiner argues that Harris'

Atty Dkt. No.: 10010010-1
USSN: 10/066,516

scanning methods, in combination with Ambrose's parallel processing system, renders claims 22, 23, 29 and 33 unpatentable.

As established above, the Harris and Rava disclosures are deficient because they fails to disclose any method that involves reading one plate at the same as processing data for another.

Ambrose, like Harris and Rava, fails to disclosure any method that involves reading one plate at the same as processing data for another. As such, Ambrose's disclosure fails to meet the deficiency of Harris and Rava.

In view of the above, the Applicants submit that Harris, Rava and Ambrose, taken in any combination, fail to teach or reasonably suggest each and every element of the rejected claims.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103 – Harris in view of Rava, Ambrose and Besemer

Claims 22 and 24-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Rava, Ambrose and Besemer. The Applicants respectfully traverse this rejection.

It is well established that correctly formulated *prima facie* case of obviousness requires that all the elements of the rejected claims are taught or reasonably suggested.

Using similar logic as that set forth above, the Applicants submit that this combination of references is deficient because they it to disclose any method that involves reading one plate at the same as processing data for another.

In view of the above, the Applicants submit that Harris, Rava, Ambrose and Besemer, taken in any combination, fail to teach or reasonably suggest each and every element of the rejected claims.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103 – Harris in view of Rava and Besemer

Claims 12, 14-15, 17, 19, 20-21 and 29-35 are rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Rava and Besemer. The Applicants

Arty Dkt. No.: 10010010-1
USSN: 10/066,516

respectfully traverse this rejection.

It is well established that correctly formulated *prima facie* case of obviousness requires that all the elements of the rejected claims are taught or reasonably suggested.

Using similar logic as that set forth above, the Applicants submit that this combination of references is deficient because they it to disclose any method that involves reading one plate at the same as processing data for another.

In view of the above, the Applicants submit that Harris, Rava and Besemer, taken in any combination, fail to teach or reasonably suggest each and every element of the rejected claims.

The Applicants submit that this rejection has been adequately addressed.
Withdrawal of this rejection is respectfully requested.

Rejection of claims under 35 U.S.C. § 103 – Harris in view of Wang

Claims 1 and 36-38 are rejected under 35 U.S.C. § 103 as being unpatentable over Harris in view of Wang. The Applicants respectfully traverse this rejection.

It is well established that correctly formulated *prima facie* case of obviousness requires that all the elements of the rejected claims are taught or reasonably suggested.

Using similar logic as that set forth above, the Applicants submit that this combination of references is deficient because they it to disclose any method that involves reading one plate at the same as processing data for another.

In view of the above, the Applicants submit that Harris and Wang, taken in any combination, fail to teach or reasonably suggest each and every element of the rejected claims.

The Applicants submit that this rejection has been adequately addressed.
Withdrawal of this rejection is respectfully requested.

Atty Dkt. No.: 10010010-1
USSN: 10/066,516

The Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone John Brady at 408-553-3584. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date:

July 21, 2006

By:


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